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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,150	04/24/2001	Richard Alan Dayan	RPS9 2001 0015	6065

47052 7590 05/16/2006	EXAMINER
SAWYER LAW GROUP LLP	LEMMA, SAMSON B
PO BOX 51418	

ART UNIT	PAPER NUMBER
2132	

PALO ALTO, CA 94303

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		09/841,150	DAYAN ET AL.
		Examiner	Art Unit	
		Samson B. Lemma	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _21 February 2006_.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-14_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-14_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

KAMBIZ ZAND
PRIMARY EXAMINER

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This office action is in reply to an amendment filed on February 21, 2006.

Independent **Claims 1 and 6 are amended**. No New claims have been added.

Therefore, **claims 1-14 are pending.**

Response to Arguments

2.   Applicant's remark/arguments filed on February 21, 2006 have been fully

considered but they are not persuasive.

Applicant's first argument is referring to the independent claims 1 and 6.

Applicant argued that some of the limitation in the independent **claims 1 and**

6 are not taught/disclosed by the references on the record namely by the

combination of the applicants admitted prior art or **AAPA and IBM Technical**

Disclosure Bulletin/Bulletin.

Applicant added the limitation that "the partition is being nonviewable and

lockable from the operating system."

Examiner disagrees with the remark. Examiner first would point out that

features of the partition is being nonviewable and **lockable from the operating**

system is explicitly disclosed by the **AAPR,** see page 1, line 14-15.

The second argument by the applicant is referring to the independent claims 1

and 6. Applicant wrote the following in order to support his argument.

"If the AAPA were combined with the Bulletin, the combination could use the

BootManager to request and validate passwords. However, because of the nature

of the feature provided, these passwords would be for partitions, or sub-

partitions, which are viewable from the operating system. Moreover, the

passwords would be provided using the BootManager utility, rather than using

BIOS during preboot. Consequently, the combination of the AAPA and the

Bulletin would still fail to teach or suggest the method and system recited in

claims 1 and 6. Accordingly, Applicant respectfully submits that claims 1 and 6

are allowable over the cited references."

Examiner disagrees with this argument.

Examiner also would point out that **AAPA** first discloses the following limitation

in claim 1, for which the applicant didn't have any argument. "**Allowing a**

plurality of sub-partitions to be defined in the partition, (Page 1, lines 8-9;

figure 1, ref. Num "20" and ref. Num "22,24,26,28") **the plurality of sub-**

partitions corresponding to a plurality of boot sources"(Page 1,lines 10; Page

2, lines 11-17) and

And **IBM Bulletin** discloses the following,

Adding a features to the **BootManager** such that when the desired bootable

partition is selected, the user is prompted to enter **a password for that**

particular partition before booting commences. By doing this, individual

partitions may be protected from unauthorized access. (Paragraph 1, lines

12-15). **This does not mean that a** separate boot manager that may query the

user later in the boot process is necessary. This only implies that the

BootManager is used as sort of interface to prompt the user to enter a password

for that particular partition. This kind of facility is also required in the applicant

invention so that the user is prompted and the user provides the sub-partition

password and be able to boot from the sub-partition.[See for instance claim 2]

Furthermore **IBM Bulletin** further discloses that this solution allows the

children to be restricted from accessing and modifying or corrupting the parents

programs or data.(Paragraph 1, lines 9-11)

The main argument by the applicant is following "the password is not provided to each plurality of sub-partition instead IBM Bulletin is providing password for each plurality of partition."

Providing password for each plurality of partition as it is taught by the IBM Bulletin and duplicating the same process and partitioning the partition further in to the sub-partition and providing password for each sub-partition as it is disclosed on the claim is obvious for one of ordinary skill in the art as long as both are used for the same purpose. The IBM Bulletin and the applicant disclosure are used for similar purpose which is to **allow different users access to different portions of the computer system to ensure that portions of the computer system remain secure.** This purpose is disclosed on the applicant disclosure as mentioned below "**According to the system and method disclosed herein, the present invention provides a more secure set of boot sources for the computer system. The boot sources allow different users access to different portions of the computer system to ensure that portions of the computer system remain secure.**"[See page 3, line 21-page 4, line 2 of the disclosure]. Like wise applicant's disclosure on page 3, line 4, discloses the following, "**It may be desirable for only certain individuals, such as the network administrator or, in a family's computer, an adult, to have access to these utilities.**"

On the other side the **IBM Bulletin** further discloses the same function as recited as follows "**that this solution allows the children to be restricted from accessing and modifying or corrupting the parents programs or data**".(Paragraph 1, lines 9-11)

From at least one of the explanations provided above, It is undoubtedly clear that the application and the reference on the record in particular IBM Bulletin have similar purpose regarding the ultimate use of the password, and since

providing a password for each plurality of partition is already disclosed then

partitioning the partition further and providing a password for each plurality of

sub-partition of the partition is obvious for one of ordinary skill in the art. It is

obvious since it is just a repetition of the same process. If one can do the first

step, then the second step is obvious for one of ordinary skill in the art.

Likewise, the examiner would also point out that, If partitioning the boot source

in to a plurality of partitioning and providing a password for each partition is

already taught in the IBM Bulletin as explained on Paragraph 1, lines 12-15 and

it is also obvious for one having ordinary skill to duplicate the same process and

continue partitioning each partition further in to the plurality of sub-partition

and providing a password for each sub-partition. Duplicating the same process

for the same purpose is obvious for one of ordinary skill in the art. In other

words, allowing a password to be provided for each plurality of partition as

oppose to duplicating the same process by partitioning each partition further in

to sub-partition and allowing a password to be provided for each plurality sub-

partition as the criterion for allowing different users access to different portions

of the computer system to ensure that portions of the computer system remain

secure, is obvious for one of ordinary skill in the art.

Applicant's other argument is regarding the dependent claims 2-5 and 7-

14.

Applicants argued that since the independent claims 1 and 6 are patentable

therefore all the claims dependent thereon are also in condition for allowance for

the same reasons argued for the independent claims 1 and 6.

In response to the above argument by the applicant, the examiner replay

discussed for the independent claims 1 and 6 above is also valid towards this

argument as the dependent claims stands and falls with the independent claims.

Therefore Examiner asserts that since the added limitation "the partition being

nonviewable and lockable from the operating system, is a feature that is already

taught by **AAPA and this limitation** does not at all change the scope of the

previous claims and since the combination of the reference discloses the claim

limitation the rejection is valid.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or
> described as set forth in section 102 of this title, if the differences between the
> subject matter sought to be patented and the prior art are such that the subject
> matter as a whole would have been obvious at the time the invention was made to a
> person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   **Claims 1-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over

admitted prior art (hereinafter referred to as **Admission**) in view of IBM technical

disclosure Bulletin ,TDB-ACC-NO: NN9611103 (reference U) (hereinafter referred to as

IBM)

5.   **As per claim 1 and 6, Admission** discloses a method for providing a trusted

boot source in a computer system,

The computer system (Page 1,line 6; fig 1, ref. Num "10") including

A partition (Page 1, lines 8-9; fig 1, ref. Num "20") and

An operating system,(Page 1, line 4, fig 1, ref. Num "12")

The partition being nonviewable and lockable from the operating system,(Page 1, line 14-15)

The method comprising the steps of:

- Allowing a plurality of sub-partitions to be defined in the partition, (Page 1, lines 8-9; figure 1, ref. Num "20" and ref. Num "22,24,26,28") the plurality of sub-partitions corresponding to a plurality of boot sources;(Page 1,lines 10; Page 2, lines 11-17) and

- Admission discloses that the computer system might have other boot devices which is not shown on submitted figure 1, and these boot devices might be accessed by a user only with a password. (Page 1, lines 11-13)

- Admission does not disclose expressly allowing a password to be provided for each of the plurality of sub-partitions, **utilizing a basic input output system (BIOS) for the computer system**, the password being required for a user to utilize a corresponding sub-partition as a boot source.

However, in the field of endeavor **IBM**, discloses

- Adding a features to the BootManager such that when the desired bootable partition is selected, the user is prompted to enter a password for that particular partition or sub-partition before booting commences.(Paragraph 1, lines 12-15)

- IBM further discloses that this solution allows the children to be restricted from accessing and modifying or corrupting the parents programs or data.(Paragraph 1, lines 9-11) (The submitted disclosure on page 3, line 4, mentioned this scenario)

It would have been obvious to one having ordinary skill in the art, at the time

the invention was made, to add the features of requiring a particular password

for accessing and utilizing the corresponding partiton as per teachings of IBM in

to the method as taught by Admission, in order to provide a secure/trusted boot

source and booting system.

6.   **As per claims 2 and 7**, the combination of Admission and IBM discloses the

method of providing a trusted boot source as applied to claims 1 and 6 above.

Furthermore, IBM discloses the method further comprising the step of: (c) allowing a

user to boot from a sub-partition of the plurality sub-partitions if the user provides the

password for the sub-partition. (Paragraph 1, lines 12-15)

7.   **As per claims 3 and 8,** the combination of Admission and IBM discloses the

method of providing a trusted boot source as applied to claims 1 and 6 above.

Furthermore, Admission discloses the method wherein, the partition (figure 1, ref. Num

"20") is stored in a hardfile (figure 1, ref. Num "30") in the computer system.(figure 1,

ref. Num "10") (Page 1, lines 7-8; figure 1, ref. Num "10"; ref. Num "20", ref. Num "30")

8.   **As per claims 4 and 9**, the combination of Admission and IBM discloses the

method of providing a trusted boot source as applied to claims 3 and 8 above.

Furthermore, Admission discloses the method wherein an identity of each of the

plurality of sub-partitions and the password for each sub-partition is stored in the

hardfile.(figure 1, ref. Num "30") and

IBM discloses how each partition is accessed with its corresponding password,(

Paragraph 1, lines 12-15) (the combinations of IBM and the admission meets the

recitation of this limitation)

9.   **As per claims 5 and 10,** the combination of Admission and IBM discloses the

method of providing a trusted boot source as applied to claims 1 and 6 above.

Furthermore, Admission discloses the method wherein the partition is lockable from the

operating system.(Page 1,lines14-15)

10.   **As per claims 11 and 14,** the combination of Admission and IBM discloses the

method of providing a trusted boot source as applied to claims 1 and 6 above.

Furthermore, the combination of Admission and IBM discloses the method wherein the

partition includes at least one additional sub-partition not requiring a password. **(See**

the argument provided for this particular claim above. That is providing a password

for each sub-partition is obvious for one of ordinary skill in the art as explained for the

independent claims 1 and 6. If providing the password is obvious for each sub-partition

then **not providing a** password for at least one sub-partition is an arbitrary design

choice. Elimination of an element and its function is nothing but a design choice. See In

re Karlson, 153 USPQ184 (CCPA 1963).)

11.   **As per claims 12 and 13,** the combination of Admission and IBM discloses the

method of providing a trusted boot source as applied to claims 1 and 6 above.

Furthermore, IBM discloses the method further comprising utilizing an additional

password for the partion. [Paragraph 1, lines 12-15]

(IBM Bulletin discloses the following,

Adding a features to the **BootManager** such that when the desired bootable partition is

selected, the user is prompted to enter a password for that particular partition before

booting commences. By doing this, individual partitions may be protected from

unauthorized access. (Paragraph 1, lines 12-15)

If providing a password for each partition is already known then duplicating the process

and providing an additional password is an arbitrary design choice. Duplicating the

same process for the same purpose is an arbitrary design choice. In other words,

allowing a password to be provided for each plurality of partition as oppose to

duplicating the same process by providing additional password as the criterion for

allowing different users access to different portions of the computer system to ensure

that portions of the computer system remain secure, is a matter of arbitrary design

choice and does not patentably distinguishes the claimed inventions from the references

on the record. See St. Regis Paper Co. v.Bemis Co., Inc., 193 USPQ 8 (7TH Cir. 1977)).

Conclusion

12.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Samson B Lemma whose telephone number is 571-272-

3806. The examiner can normally be reached on Monday-Friday (8:00 am---4: 30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, BARRON JR GILBERTO can be reached on 571-272-3799. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

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SAMSON LEMMA
S·L·
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KAMBIZ ZAND
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